

REMARKS

Applicant has carefully reviewed and considered the Non-final Office Action mailed on 30 December, 2005, and the references cited therewith.

The claims are unchanged; as a result, claims 10-16 and 18-37 are now pending in this application. Please charge any required fee to deposit account 19-0743.

Please note that the current non-final Office Action copied verbatim all of the Final Office Action of 10/13/05 (FOA), which in turn copied verbatim most of its prior Office Action of 18 April 2005. Applicant put significant effort into the Response filed 12/13/05, yet the Examiner has failed to acknowledge the arguments presented therein except the request to withdraw finality.

Further, Applicant amended claims 16 and 18 in Applicant's Amendment and Response filed 21 July 2005, but the Non-Final Office Action, just like the Final Office Action before it, does not acknowledge nor address the amendments, but rather copies verbatim rejections from the 18 April 2005 Office Action that referred to previous wordings in these two claims.

Since the current Office Action again failed to even acknowledge the changed claims 16 and 18 from Applicant's 21 July 2005 response, Applicants respectfully request that the Examiner consider all the arguments and that the claims be allowed or a non-final Office Action be issued that examines the previously amended claims and previously added new claims. The following section regarding the 102(e) rejection based on Anderson is unchanged from Applicant's 12/13/05 response, but is repeated here solely for the Examiner's convenience. Applicant points out that Anderson states only in the background section [0004] that "following review of the transactions, a customer *may wish* to submit a payment electronically." and "The present invention (ConductorSM) is a suite of online financial services. Supported functions include credit card account lookup and reporting, and checking and bill paying. " There is no indication that the described invention of Anderson would or could accept a transaction from a customer and no enabling disclosure. Anderson in paragraph [0033] says "Preferably, users may view and manipulate only their own financial data. Furthermore, users may not alter the data. Preferably, users have the option of downloading the financial data to an accounting software package "

Argument

Rejection Under 35 U.S.C. § 102(e)

1) The Applicable Law for Rejections Under 35 U.S.C. § 102(e)

The Applicable law was provided in the Applicant's Amendment and Response filed 21 July 2005 and is not repeated here. Please refer to the remarks in that response.

2) The 35 U.S.C. § 102(e) Rejections

Claims 10-16 and 18-34 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson et al. (hereinafter "Anderson") U.S. Patent Application No. 20040158524. Applicants respectfully traverse the rejection. Anderson describes a system wherein a customer accesses a web page of a financial services provider using the customer's computer and browser, is connected to a database that allows the user to download credit card or debit card transactions (see paragraph [0033]). There is no description or suggestion that the system would or could receive "a second transaction from a service consumer," but rather the reference says "Furthermore, users may not alter the data."

Analysis

Anderson fails to anticipate the present claims, since it does not contain each and every element as set forth in the claim, either expressly or inherently described (*See Verdegaal, supra*). Anderson fails to teach or suggest receiving or storing both the second transaction by the service consumer (Anderson's "user") and the first transaction by the service provider (Anderson's "financial services provider" or "Conductor host") into the database, wherein access to the transactions is selectively enabled to the service consumer/customer based on an identification of the service consumer, and wherein the transactions are then accessed by the service consumer/customer. The Office Action mailed April 19, 2005, points to paragraphs [0026] and [0033], neither of which show a plurality of transactions for a database including one from a service consumer and one from a service provider.

Although Anderson uses the word "transaction," the meaning of that word as used by Anderson is of a credit or debit card transaction (see paragraph [0027]) and is not the same as "transaction" as used in the present application (i.e., in the present invention, the transactions are computer-actionable data that add to or modify information in a database).

Further, as far as Applicant can determine, Anderson does not receive any transactions from a service consumer, and in fact in paragraph [0033] says

“Preferably, users may view and manipulate only their own financial data. Furthermore, **users may not alter the data.** Preferably, users have the option of downloading the financial data to an accounting software package such as Intuit's Quicken, or a word-processing program such as Novell's WordPerfect.”

In contrast, the invention recited in claim 10 of the present application provides “**selectively enabling access by the service consumer, based on an identification of the service consumer, to the stored first and second transactions associated with the service consumer to whom access is enabled.**” The Examiner points to paragraph [0033] and the abstract of Anderson. Applicant can find no teaching or suggestion in these sections of Anderson cited by the Examiner that enable the customer, based on identification of the customer, to access those defined transactions in the database system (as recited in claim 10 and claim 14).

In contrast, the present invention as recited in claims 10 and 14 provides a method (or media having the method) comprising:

receiving a plurality of **transactions for the database system including a first transaction from a service provider and a second transaction from a service consumer**, wherein the first and the second transactions are each associated with the service consumer;
storing the plurality of transactions into the database system; and
selectively enabling access by the service consumer, based on an identification of the service consumer, to the stored first and second transactions associated with the service consumer to whom access is enabled. (*emphasis added*)

The recited combination of transactions and the selective enabling of accesses to the database distinguish the present invention from Anderson. Accordingly, reconsideration and allowance of these claims and their dependent claims is respectfully requested.

As to dependent claims 11, 15, and 32, Anderson describes a user's access to, and download of, a credit or debit card transaction. There is nothing about any docketing function or provider. The Office Action has failed to provide a *prima facie* case of anticipation. The claimed combination where the method further includes "receiving transactions by a docketing provider" is clearly distinguished. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claims 12, 20, 26 and 33, Anderson describes nothing of pending action items, but rather is a record of past credit-card transactions on a daily basis. In contrast, this feature of the

present invention is useful for such professions as law and others. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claim 16, Anderson describes a credit card transaction database viewing service, not a database to support a patent application service provider. In contrast, the present invention is useful for such professions as law and others. Reconsideration and allowance of this claim is respectfully requested.

As to claim 18, this claim and its dependent claims are means-plus-function claims, and must be examined under 35 U.S.C. § 112 paragraph 6, to be the structure and acts described in the present invention and equivalents thereof. The Office Action has failed to provide a reference with the required equivalents as analyzed under 35 U.S.C. § 112 paragraph 6. Accordingly, reconsideration and allowance of these claims is respectfully requested. The Anderson reference does not describe nor suggest transactions that “are each transactions that add information regarding a patent application to the database.” Accordingly, reconsideration and withdrawal of this rejection is respectfully requested, and an early notification of allowance be provided.

As to claims 22 and 28, Anderson does not describe extracting a database transaction from an electronic message. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claims 23 and 29, Anderson does not describe an input device for a database transaction, but rather a generic input device. Applicant cannot find any indication that this input device is used for entering a database transaction in Anderson. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to the remaining claims not separately discussed above, each is dependent on a claim that appears allowable, as discussed above. Further, each describes further limitations that form a combination with the respective parent claim, and these combinations are also not described in the cited reference. Accordingly, reconsideration and allowance of these claims is respectfully requested.

Applicant respectfully request reconsideration of the rejections of claims 10-16 and 18-34.

Rejection Under 35 U.S.C. § 103(a)

Claims 35-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. (hereinafter "Anderson") U.S. Patent Application No. 20040158524 in view of Whitmyer (U.S. Patent Application No. 20020029215). Applicants respectfully traverse the rejection. The present application was filed 11 September 2000 (before the 29 November 2000 filing date of Whitmyer, which is continuation of application 09/612,420 which claims priority to U.S. Provisional Patent Application 60/143,092; The Examiner provided neither of the two earlier documents, and neither of them is available from Public PAIR). Applicants respectfully reserve the right to swear a date of invention behind the filing date of the earlier applications if they are relevant, once the Examiner provides copies of them. Even if the Whitmyer application is applicable 103(a)/102(e) prior art, Applicants respectfully submit that Whitmyer is not relevant to the patentability of the present claims 35-37, because Anderson does not describe nor suggest the invention (as described above for claim 1), and Whitmyer does not describe nor suggest an attorney involved in its system. The IP office 32 has an arrow into it, with no arrow back. There is no description or suggestion that an attorney is in the IP office 32 (since it is described as the recordation facility for transfer of IP, function that merely records documents and does not require an attorney) and no indication of any transactions passing FROM the IP office 32 to the TAS 20. Whitmyer, for recording an IP transfer, provides a

" database of documents 36 for documents necessary to complete said transfer. The TAS 20 then queries a database of intellectual property information records 34 for information necessary to complete said transfer. Next, the TAS 20 combines said necessary documents with said necessary intellectual property information records and said transaction information (not shown).

[0016] The TAS 20 transmits the combined documents 22 to the client 10 by any mechanism known to one skilled in the art, e.g., said communications link, facsimile, etc. The client 10 reviews, edits, and signs documents by electronic signature, traditional writing implement, or any method known to one skilled in the art (not shown). The client 10 transmits said signed documents 24 to the TAS 20 by any mechanism known to one skilled in the art, e.g., said communications link, facsimile, etc. In addition, the TAS may repeat this exchange with additional parties where the signatures of said additional parties are necessary to complete the transfer of said intellectual property (not shown).

[0017] Upon receipt of said signed documents 24 from the client 10, the TAS 20 may review said signed documents for errors or omissions (not shown). The TAS 20 then transmits said signed documents, by any mechanism known to one skilled in the art, to any intellectual property authority 32 required for the completion of said transfer of intellectual property. "

Applicants respectfully submit that since neither Anderson nor Whitmyer teach, disclose or suggest "receiving a plurality of transactions for the database system including a first transaction from a service provider associated with an intellectual property law lawyer and a second transaction from a service consumer, wherein the first and the second transactions are each associated with the service consumer and are each transactions that add information regarding a patent application to the database" as recited in claim 35, no combination thereof can render these claims obvious.

Further, it is well settled that the mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir 1990). If the proposed modification would render the prior-art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir 1984). In the present case, there is absolutely no suggestion in the prior art to modify the Anderson database of credit-card and checking records to accept intellectual property transactions. Applicant submits that changing a financial database of credit card transactions to receive "a plurality of transactions for the database system including a first transaction from a service provider associated with an intellectual property law lawyer and a second transaction from a service consumer, wherein the first and the second transactions are each associated with the service consumer and are each transactions that add information regarding a patent application to the database" would render the Anderson database unsuitable for its original purpose. Accordingly, reconsideration and withdrawal of the rejection and an early indication of the allowability of these claims is respectfully requested.

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested.

Conclusion

It is respectfully submitted that the cited art neither anticipates nor renders the claimed invention obvious and that therefore the claimed invention does patentably distinguish over the cited art. It is respectfully submitted that claims 10-16, 18-34, and 35-37 should be allowed in view of the arguments presented. Reconsideration and withdrawal of the Examiner's rejections of claims 10-16 and 18-37 is respectfully requested.

The Examiner is invited to telephone Applicant's attorney (952-278-3501) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CHARLES A. LEMAIRE ET AL.

By their Representatives,

LEMAIRE PATENT LAW FIRM, P.L.L.C.
P.O. Box 2938
Minneapolis, MN 55402
(952) 278-3501

Date 30 March 2006

By Charles A. Lemaire
Charles A. Lemaire
Reg. No. 36,198

CERTIFICATE UNDER 37 C.F.R. 1.8: I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on this 19th day of July 2005.

Charles A. Lemaire
Name

Charles A. Lemaire
Signature